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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,120	02/28/2002	Gerald Steiner	GEST.001A	3606
7663	7590	05/17/2006		
STETINA BRUNDA GARRED & BRUCKER 75 ENTERPRISE, SUITE 250 ALISO VIEJO, CA 92656			EXAMINER NGUYEN, KIMBERLY D	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/090,120

Applicant(s)

STEINER, GERALD

Examiner

Kimberly D. Nguyen

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,14-17 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,14-17 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Amendment*

1. Acknowledgment is made of Amendment filed January 26, 2006.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-4, 16-17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (US 6,536,659; hereinafter "Hauser") in view of Sloane (US 5,918,211).

Re claims 1, 3, 17, and 21: Hauser teaches a package (e.g., goods, merchandise, etc) for mailing items from a merchant to a customer (col. 2, lines 19-20), the package comprising

at least one surface, the surface having barcode thereon, wherein the barcode identifies the customer ("This label includes a scannable bar code identifying the merchant and the customer" (abstract)) (col. 2, lines 9-67; col. 3, line 43 through col. 6, line 49). The barcode is scanned to identify the customer and the merchant and, to credit the customer (or the customer's account) for the returned merchandise (col. 5, lines 15-35). Which the barcode includes an order and return history of the merchandise mailed to the customer.

Hauser does not specifically disclose the barcode includes the history of prior purchases and returns other than the item mailed.

Sloane teaches scanning the barcode 32 on the shopper's frequent shopper card 30 will call up the shopper's purchase history, offering the shopper discounts, promotions or other information based upon his past purchasing history (fig. 10; Abstract; col. 9, lines 5-19).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the barcode identifying customer with the history of order and return of the merchandise mailed as taught by Hauser with additional customer's past purchase history thereon as taught by Sloane in order to offer discounts, promotions or other information based upon the consumer's past purchase history (col. 9, lines 8-13).

Furthermore, the barcode as taught by Hauser is inherently capable of performing the functionality of being encoded/extracted with the customer's past purchasing and returning history as set forth in the claims. Moreover,

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Claiming a new function does not necessarily make an apparatus claim patentable. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Re claims 4 and 16: Hauser teaches scanning the bar code enables the merchant to identify items in which the customer is interested ("The data identify the merchant and the merchandise purchased by a customer" (col. 2, lines 19-20)).

4. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of Neely et al. (US 5,722,538; hereinafter "Neely").

Re claims 5-6: Hauser teaches a method of tracking an order and return history of a customer, the method including the steps of:

providing a package including a bar code (the return label having a scannable bar code thereon) that identifies the customer (abstract; col. 2, lines 10-27; col. 4, lines 30-35);

receiving the package from the customer, the package containing returned items (col. 2, lines 10-27; col. 4, lines 36-40);

scanning the bar code to identify the customer (abstract, lines 8-9);

inputting the returned items into an inventory database (col. 2, lines 28-38; col. 5, lines 6-20); and

updating the customer's order and return history (col. 2, lines 49-67; col. 5, lines 21-44).

Hauser fails to teach or fairly suggest the package containing a flat disk having recorded thereon audio or audiovisual information, in other words, such as compact discs (CD's), digital versatile discs (DVD's) as described on page 6, lines 6-13 of the instant Specification.

Neely teaches a package containing a flat disk having recorded thereon audio or audiovisual information, such as compact discs (CD's) for mailing/delivering (col. 5, lines 36 through col. 6, line 53).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a package containing a flat disk such as audio compact disc for mailing as taught by Neely to the teachings of Hauser in order to keep track of package containing the merchandise/compact-disc during delivering and returning process.

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser as modified by Neely as applied to claim 1 above, and further in view of Savino et al. (US 6,015,167; hereinafter "Savino"). The teachings of Hauser as modified by Neely have been discussed above.

Hauser as modified by Neely fails to specifically teach the customer is identified by name/address.

Savino teaches a system and method for employing a single bar code for coordinating shipping, wherein the customer is identified by customer name and address (fig. 5; col. 3, line 62 through col. 4, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the conventionally well-known identifying customer by name/address as taught by Savino to the teachings of Hauser as modified by Neely in order positively identify the customer's name and residence.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection as set forth above.

#### ***Conclusion***

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'KDN', with a long horizontal flourish extending to the right.

KDN  
May 13, 2006